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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,647	11/13/2001	Hong Xu	PC-0052 CIP	2174

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EXAMINER

BASI, NIRMAL SINGH

ART UNIT PAPER NUMBER

1646

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/992,647

**Applicant(s)**

XU ET AL.

**Examiner**

Nirmal S. Basi

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 13 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-18 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### 2. *Election/Restriction*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2, 6, drawn to isolated polypeptide, array containing said protein, classified in class 530, subclass 350.
- II. Claims 3, 4 drawn to a method using the protein of claim 1 to screen for ligands by detecting specific binding, classified in class 435, subclass 7.1.
- III. Claim 5 drawn to a method using the protein of claim 1 to purify compounds which specifically bind to said polypeptide, recover said compound and separate the compound from the polypeptide, classified in class 530, subclass 412.
- IV. Claims 7, 8, 12, 16 and 18 drawn to antibody, an array containing said antibody and to a method using the protein of claim 1 to prepare and purify polyclonal or monoclonal antibodies, which specifically bind to said polypeptide, recover said compound and separate the antibodies from the polypeptide, classified in class 424, subclass 130.1.
- V. Claim 9 drawn to a method using the protein of claim 1 to screen for antibodies which specifically bind said protein, classified in class 435, subclass 7.1.

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- VI. Claim 10 drawn to method of testing a compound for effectiveness as an agonist for the protein of claim1, classified in class 435, subclass 7.1.
- VII. Claim 11 drawn to method of testing a compound for effectiveness as an antagonist for the protein of claim1, classified in class 435, subclass7.1.
- VIII. Claims 13, 14 and 15 drawn to method for using an antibody to detect expression of a protein in a sample wherein a complex formation is diagnostic of lung cancer or eosinophilia, classified in class 435, subclass 7.1.
- IX. Claim 17 drawn to method for using the antibody of claim, classified in class 530 class 412

The inventions are distinct, each from the other because of the following reasons:

The proteins of Invention I are related to antibodies of Invention III by virtue of being the cognate antigen, necessary for the production of the antibodies. Although the protein and antibody are related due to the necessary stearic complementary of the two, they are distinct inventions because they are physically and functionally distinct chemical entities, and because the protein can be used in another and materially different process from the use for production of the antibody, such as in a pharmaceutical composition in its own right or in assays for the identification of agonists of the receptor protein.

The proteins Inventions I and the methods of Inventions II-VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be

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practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the proteins may be used for the production of antibodies of Invention III.

The proteins of Invention I are distinct from the methods of Invention VIII and IX wherein the protein of Invention I can neither be used in nor made by the methods of Invention VIII and IX.

The methods of Inventions II-IX are distinct from each other because they are independent, using separate method steps, active agents and having different effects.

The antibody Inventions IV and the methods of Inventions VIII and IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody may be used for the production of secondary antibodies for use in immunoassays.

The antibody of Invention IV are distinct from the methods of Invention II-III and V-VII wherein the protein of Invention I can neither be used in nor made by the methods of Invention II-III and V-VII.

The methods of Inventions II-IX are distinct from each other because they are independent, using separate method steps, active agents and having different effects.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art, restriction for examination purposes as indicated is

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proper. A search of the art for Inventions I-IX would not be co-extensive with each other. Because the searches required for these inventions are not co-extensive an examination of the materially different, patentably distinct inventions in a single application would constitute a serious burden on the examiner.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the search required for each group is not required for the other groups because each group requires a different non-patent literature search due to each group comprising different products and/or method steps, restriction for examination purposes as indicated is proper.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March

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26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirmal S. Basi whose telephone number is 571-272-0868. The examiner can normally be reached on 9:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda G Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nirmal S. Basi  
Art Unit 1646  
September 29, 2004

  
**BRENDA BRUMBACK**  
SUPERVISORY PATENT EXAMINER  
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